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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,309	03/01/2004	Peter J. Whitehead		9329
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			EXAMINER	
			SHAFER, RICKY D	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/790,309	WHITEHEAD, PETER J.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ricky D. Shafer	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 17 January 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-21,24-41 and 48-68 is/are pending in the application.  
 4a) Of the above claim(s) 3-7,11,15,18,19 and 24-41 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2,8-10,12-14,16,17,20,21,48 and 50-68 is/are rejected.  
 7) Claim(s) 49 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 01 March 2004 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 03/01/2004.
- 4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

1. Applicant's election of species "X", the support being adapted to mount the mirror assembly to a windshield, in the reply filed on 1/17/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 11 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/17/2005.
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Ochiai et al ('898).

Ochiai et al discloses a vehicular interior rearview mirror system comprising an interior rearview mirror assembly; said interior rearview mirror assembly comprising a mirror casing having a reflective element (20) with a rearward field of view; said interior rearview mirror assembly further comprising a support (21) being adapted to mount said mirror assembly to a vehicle; and an electrical actuator (72) located interiorly of said interior rearview mirror assembly, said electrical actuator cooperating with said support to provide adjustment of said mirror casing about said support when said electrical actuator is actuated to thereby provide adjustment of said rearward field of view of said reflective element about one or more axes when said actuator is actuated, wherein said reflective element serves as a variable reflectance element, when said reflective element is switched from a day time condition to a night time condition.

Note Fig. 5 along with the associated description thereof.

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5:       Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakaho ('488).

Nakaho discloses a vehicular interior rearview mirror system comprising an interior rearview mirror assembly; said interior rearview mirror assembly comprising a mirror casing (3) having a reflective element (20) with a rearward field of view; said interior rearview mirror assembly further comprising a support (1) being adapted to mount said mirror assembly to a vehicle; and an electrical actuator (6,7) located interiorly of said interior rearview mirror assembly, said electrical actuator cooperating with said support to provide adjustment of said mirror casing about said support when said electrical actuator is actuated to thereby provide adjustment of said rearward field of view of said reflective element about one or more axes when said actuator is actuated, wherein said reflective element serves as a variable reflectance element, when said reflective element is switched from a day time condition to a night time condition.

Note Fig. 1 to 6 along with the associated description thereof.

6.       Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Fukae ('641).

Fukae discloses a vehicular interior rearview mirror system comprising an interior rearview mirror assembly; said interior rearview mirror assembly (4,5) comprising a mirror casing (5) having a reflective element (4) with a rearward field of view and at least one socket (7,8); said interior rearview mirror assembly further comprising a support (1,2) being adapted to mount said mirror assembly to a vehicle; and an electrical actuator (9,11) located interiorly of said interior rearview mirror assembly having a pivot member (3,6), said electrical actuator including at least one positioning member (10,14) cooperating with said support to provide adjustment of said mirror casing about said support when said electrical actuator is actuated to thereby provide adjustment of said rearward field of view of said reflective element about one or more axes when said actuator is actuated, wherein said reflective element serves as a variable

reflectance element, when said reflective element is switched from a day time condition to a night time condition. Note figures 1 to 5 along with the associated description thereof.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 10, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaho ('488) or Ochiai et al ('898).

Nakaho and Ochiai et al each disclose all of subject matter claimed, note the above explanation, except for explicitly stating that the support is tubular and is adapted to mount to a windshield of a vehicle with a break-away connection.

It is well known to use a break-away connection at end one of a tubular support for an interior rearview mirror assembly in the same field of endeavor for the purpose of attaching an interior rearview mirror assembly to a windshield of a vehicle.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the vehicle attachment end of the support of Nakaho or Ochiai et al to be tubular and include a break-away connection, as is well known and commonly used and employed in the art, in order to reduce the weight of the mirror assembly and reduce to prevent possible injuries to occupants within the vehicle.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakaho ('488), Ochiai et al ('898) or Fukae ('641).

Nakaho, Ochiai et al and Fukae each disclose all of subject matter claimed, note the above explanation, except for one or more electrical devices positioned in a compartment between the back wall of the mirror casing and the reflective element.

It is well known to use an electrical device, such as an electrochromatic film, positioned between a mirror casing and a reflective element in the same field of endeavor for the purpose of obtaining particular optical reflection characteristics of interest.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify Nakaho, Ochiai et al or Fukae to include an electrical device such as an electrochromatic film, between the mirror casing and reflective element or alternatively modify the reflective element to include an electrochromatic film, as is well known in the art, in order to obtain desirable optical reflection characteristics of interest.

10. Claims 10, 14, 16, 17, 48 and 50-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukae ('641).

Fukae discloses all of subject matter claimed, note the above explanation, except for explicitly stating that the support is tubular and is adapted to mount to a windshield of a vehicle with a break-away connection.

It is well known to use a break-away connection at end one of a tubular support for an interior rearview mirror assembly in the same field of endeavor for the purpose of attaching an interior rearview mirror assembly to a windshield of a vehicle. (Note the references cited by the examiner).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the vehicle attachment end of the support of Fukae to include a break-away connection, as is well known and commonly used and employed in the art, in order to reduce the weight of the mirror assembly and to prevent possible injuries to occupants within the vehicle.

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As to the limitations of claims 51 and 52, it is well known to use rain sensors in the same field of endeavor for the purpose of detecting the moisture on the windshield. (See page 4, lines 20 to 27 of applicant's specification, i.e., U.S. Patent 4,973,844).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the windshield of a vehicle in which said interior rearview mirror assembly of Fukae is to be installed to include a rain sensor or the support (housing) of the rearview mirror assembly to include a rain sensor, as is well known and commonly used and employed in the art, in order to detect moisture on the windshield so as to automatically operate the windshield wipers.

11. Claims 20, 21, 53 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fukae ('641) as applied to claims 10, 14, 16, 48, 50, 51 and 55-60 above, and further in view of O'Farrell et al ('575).

Fukae discloses all of subject matter claimed, note the above explanation, except for the actuator(s) being coupled at least one control module (system) having a mirror based control module of a mirror memory system.

O'Farrell et al teaches it is known to use at least one mirror-based control module in the same field of endeavor for the purpose of actuating actuators to adjust the positions of reflective elements of an interior and exterior rearview mirror assemblies.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the support (housing) of the rearview mirror assembly of Fukae to include a mirror based control module, as taught by O'Farrell, in order to provide a dynamic position control in a mirror memory system.

12. Claims 61 to 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over O'Farrell et al ('575) or Jain et al ('870) in view of Fukae ('641), Ochiai et al ('898) or Nakaho ('488) and Wittmann ('543) or Mizuta et al ('571).

O'Farrell et al and Jain et al each teach the basis concept of at least one mirror-based control module (38) and (33), respectively, for actuating actuators to adjust the positions of the reflective elements of an interior and exterior rearview mirror assemblies, note figures 5 and 8, respectively, except for explicitly stating the structure of the interior and exterior rear view mirror assemblies.

Fukae, Ochiai et al and Nakaho each discloses the structure of a typical interior rearview assembly recited by applicant in the same field of endeavor for the purpose of adjusting an interior rearview mirror assembly.

Wittmann and Mizuta et al each discloses the structure of a typical exterior rear view mirror assembly recited by applicant in the same field of endeavor for the purpose of adjusting an exterior rearview mirror assembly.

Therefore, it would have been obvious and/or within the level of one of ordinary skill in the art at the time the invention was made to modify the interior mirror of O'Farrell or Jain et al to include a typical interior rearview assembly commonly used and employed in the art, as taught by Fukae, Ochiai et al or Nakaho, and modify the exterior mirror(s) of O'Farrell or Jain et al to include a typical exterior rear view mirror commonly used and employed in the art, as taught by Wittmann or Mizuta et al in order to adjust the relative positions of the reflective elements of said interior and exterior rearview mirror assemblies.

13. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA

1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

14. Claims 1, 2, 8-10, 12-14, 16, 17, 20, 21 and 48-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 4, 5, 8, 9, 11 and 17 of U.S. Patent No. 6,698,905. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present application (10/790,309) discloses no additional invention or discovery other than what was already claimed and patented in U.S. Patent 6,698,905 or what would have been obvious to one of ordinary skill in the art at the time the invention was made.

U. S. Patent 6,698,905 discloses a vehicular interior rearview memory mirror system comprising an interior rearview mirror assembly including a generally cup-shaped mirror casing having a variable reflective element, a back wall and first and second sockets, wherein said reflective element is spaced from said back wall to define a cavity for containing one or more electrical components, a tubular support being adapted to mount to a vehicle and an electrical actuator having a pivot member and an extendable positioning member located exteriorly of said

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mirror casing and engaging said mirror casing to provide adjustment of said mirror casing about one or more axes.

As to the limitations that the support includes a break-away connection, it is well known to use a break-away connection at end one of a support for an interior rearview mirror assembly in the same field of endeavor for the purpose of attaching an interior rearview mirror assembly to a windshield of a vehicle.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the vehicle attachment end of the support of U.S. Patent 6, 698,905 to include a break-away connection, as is well known and commonly used and employed in the art, in order to prevent possible injuries to occupants within the vehicle.

As to the limitations that the support includes a rain sensor, it is well known to use rain sensors in the same field of endeavor for the purpose of detecting the moisture on the windshield. (See page 4, lines 20 to 27 of applicant's specification, i.e., U.S. Patent 4,973,844).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the support of U.S. Patent 6, 698,905 to include a rain sensor, as is well known and commonly used and employed in the art, in order to detect moisture on the windshield so as to automatically operate the windshield wipers.

15. Claim 49 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The disclosure is objected to because of the following informalities:

On page 21, line 21, the correct patent number should be provided.

Appropriate correction is required.

17. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the rain sensor must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ricky D. Shafer whose telephone number is (571) 272-2320. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RDS

March 19, 2005

*Ricky D. Shafer*  
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PATENT EXAMINER  
ART UNIT 2507 2872